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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JOYNER, KEVIN

ART UNIT

PAPER NUMBER

1797

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/699,274	SU-SYIN, WU	
	Examiner	Art Unit	
	KEVIN C. JOYNER	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/08</u> . | 6) <input type="checkbox"/> Other: _____ |

FINAL ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Page 6 of the Specification refers to the apertures as numeral 32 and the projections as numeral 34 in lines 25 and 26 respectively. However, it appears that the apertures are labeled as numeral 30 and the projections are labeled as 32 in Figure 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, each one of claims 21-24 provide limitations of a first and second set of ridges wherein the ridges are discontinuous to create a first and second aperture therein wherein the apertures are configured to allow a fluid to flow therethrough. The specification is insufficient in

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supporting that the ridges create the apertures and that the apertures are configured to allow a fluid to flow therethrough.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 8-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieze et al. (U.S. Patent No. 5,766,561) in view of Adam (U.S. Patent No. 5,815,995).

6. Concerning the limitations of claims 1, 2, 6, 8 11 and 14-18, Frieze discloses a method and apparatus of a sterilization container system comprising: an enclosure (12) defining an interior volume (as shown in Figure 1); an upwardly facing surface in the interior volume (as shown in Figure 2); a flexible elastomeric mat (10) formed of silicone (as disclosed in the title), having a downwardly facing surface resting upon the upwardly facing surface (as shown in Figure 1); and a pattern of ridges extending from the downwardly facing surface (as shown in Figure 3B). Frieze does not appear to disclose that the pattern on the downwardly facing surface is such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges. Adam discloses a flexible elastomeric mat having a downwardly facing surface and an upwardly facing surface wherein the downwardly facing surface rests upon an upwardly

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facing surface (Figures 1-7). The reference continues to disclose that a pattern of ridges extend from the downwardly facing surface, wherein the pattern of ridges is such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges, said pattern being a continuous pattern that extends substantially across a dimension of the lower surface (concerning claim 17, 18Figure 6A). The pattern is provided in order to produce a set of recesses that allow said mat to cushion an object that may be present on the upwardly facing surface (column 2, lines 1-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Frieze to include a pattern of ridges extend from the downwardly facing surface, wherein the pattern of ridges is a continuous pattern that extend substantially across a dimension of the lower surface such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges in order to produce a set of recesses that allow said mat to cushion an object that may be present on the upwardly facing surface as exemplified by Adam.

7. In regards to the limitations of claims 3-5, Frieze in view of Adam is relied upon as set forth in reference to the limitations stated above. Claims 3-5 further require that the ridges have a height of 1.0 to 4.0 mm. It would have been well within the purview of one of ordinary skill in the art to optimize the length of the ridges between 1.0 to 4.0 mm maximize the cushioning affect of said pattern. Only the expected results would be attained. Concerning the limitation of claims 9, 10 and 20, Frieze further discloses that the mat further comprises a plurality of upwardly projecting members (as shown in Figure 2 labeled numeral 30) as well as a plurality of apertures therethrough (as shown

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in Figures 4A and 4B labeled numeral 40). Concerning the limitations of claims 12 and 19, as broadly defined Frieze also discloses a discontinuous pattern of "S" shaped ridges from one side of the mat to the other in Figure 3B.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frieze et al. (U.S. Patent No. 5,766,561) in view of Adam (U.S. Patent No. 5,815,995) as applied to claim 6 above, and further in view of Kerr et al. (U.S. Pub. No. US 2001/0046582).

9. Frieze in view of Adam is relied upon as set forth in reference to claims 1-6, and 8-14 above. Frieze in view of Nord does not appear to disclose that the silicone has a hardness of less than 90A on the Shore A Scale. Kerr discloses a novel cleated anti-creep floor mat made with silicone having a hardness of less than 90A on the Shore A Scale (column 3, paragraph 19). It would have been obvious to one of ordinary skill in the art at the time of the invention to comprise the silicone material with a hardness of less than 90A on the Shore A Scale in order to provide the necessary cushioning effects as exemplified by Kerr.

10. Claims 1, 13, 15 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieze et al. (U.S. Patent No. 5,766,561) in view of Nakahira (U.S. Patent No. 4,429,068).

11. Frieze discloses a method and apparatus of a sterilization container system comprising: an enclosure (12) defining an interior volume (as shown in Figure 1); an upwardly facing surface in the interior volume (as shown in Figure 2); a flexible elastomeric mat (10) formed of silicone (as disclosed in the title), having a downwardly facing surface resting upon the upwardly facing surface (as shown in Figure 1); and a

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pattern of ridges extending from the downwardly facing surface (as shown in Figure 3B).

Frieze does not appear to disclose that the pattern on the downwardly facing surface comprises a pattern of concentric shapes such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges. Nakahira discloses a flexible elastomeric mat having a downwardly facing surface and an upwardly facing surface such that the downwardly facing surface rests upon the upwardly facing surface (Figures 1-6). The reference continues to disclose that said mat comprises a pattern of concentrically shaped ridges wherein the pattern is such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge (column 10, lines 40-66; Figures 1-6). Said pattern and ridges are provided in order to reduce vibrations that may disturb an object located on the upward facing surface of said mat. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Frieze to include pattern of concentrically shaped ridges on a downwardly facing surface wherein the pattern is such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge in order to reduce vibrations that may disturb an object located on the upward facing surface of said mat as exemplified by Nakahira.

With regard to claims 21-24, as shown in Figure 3B, Frieze continues to disclose that the pattern of ridges further comprises:

A first set of ridges, wherein at least one ridge of the first set of ridges is discontinuous to create a first aperture (40) therein, wherein the first aperture is

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configured to allow fluid to flow therethrough, and wherein a first ridge of the first set of ridges does not intersect with a second ridge of the first set of ridges; and

A second set of ridges, wherein at least one ridge of the second set of ridges is discontinuous to create a second aperture therein, wherein the second aperture is configured to allow a fluid to flow therethrough, wherein a first ridge of the second set of ridges does not intersect with a second ridge of the second set of ridges, wherein the first aperture is configured to be in fluid communication with the second aperture such that a fluid can flow through the first aperture and the second aperture. More specifically, as shown in Figure 3B, the ridges (38) are configured in first and second sets both longitudinally and laterally, wherein first and second apertures (40) are created therein that allow fluid to flow therethrough. As shown in Figure 3B as well, the ridges in each set do not intersect with each other and are discontinuous. Frieze does not appear to disclose that the first set of ridges are positioned one of perpendicular and transverse to the second set of ridges, wherein at least the first ridge of the first set of ridges intersects with at least the first ridge of the second set of ridges. However, Nakahira also discloses this configuration in Figures 1-6 and column 10, lines 40-65. More specifically, the outer edges of each array (5a-c) are also provided with ridge like projections as shown in Figures 1, 7, and 8 (column 10, lines 42-50), wherein these edges provide a set of ridges. As disclosed in Figure 2, ridge like projections (4a) are also located perpendicular and transverse to the outer edge ridge like projections. These ridges (4a) constitute a second set of ridges that intersect the first set of ridges. This configuration is provided in order to inhibit vibrations, absorb shock, resist impact,

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and offer cushioning properties during various procedures (column 4, lines 25-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ridge configuration of Frieze to position the first set of ridges perpendicular and transverse to the second set of ridges, wherein at least the first ridge of the first set of ridges intersects with the first ridge of the second set of ridges in order to inhibit vibrations, absorb shock, resist impact, and offer cushioning properties during various procedures as exemplified by Nakahira.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-24 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 15-34 of

copending Application No. 11/958,904. Although the conflicting claims are not identical,

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they are not patentably distinct from each of the claims are directed to a sterilization container system comprising an enclosure comprising a mat with an upwardly facing surface and a downwardly facing surface wherein the downwardly facing surface comprises a projection of ridges in a configuration such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

14. Applicant's arguments filed July 11, 2008 have been fully considered but they are not persuasive.

Applicant's principle arguments are:

(a) Adam does not disclose a mat with the features of a pattern on a downwardly facing surface is such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges but, instead, discloses a slip-resistant floor tile which is not a mat.

A mat is defined as a flat piece of coarse fabric or other material used for wiping one's shoes or feet, or in various other forms as a floor covering. Adams clearly discloses that the apparatus of the present invention is a, "slip resistant floor covering [that] comprises a slip resistant tile..." (column 2, lines 24-25). Therefore, the apparatus of Adams is a mat that comprises tiles.

(b) Adam is not within an analogous art to the art of Independent claims 1, 14, and 15 and, therefore cannot be used in a 35 U.S.C. 103(a) rejection thereof. Applicant respectfully submits that such an endeavor is simply not within the field of the invention of Independent claims 1, 14, and 15, i.e., a mat for use in a sterilization container system which is configured to prevent, or at least inhibit, fold lines from traversing the mat which can, in various circumstances, prevent medical instruments positioned on the upwardly facing surface of the mat from contacting each other, or otherwise shifting, during a sterilization process. The purpose of the device of Adam is to provide a slip-resistant floor tile which reduces the risk that an individual may slip or fall on a slippery floor surface by supporting the individual's foot at an elevation above that of liquid and/or other potentially slip inducing substances. One of ordinary skill in the medical instrument sterilization art would not look to a modular slip-resistant floor tile to find the solution to the problem of keeping a medical instrument mat within a sterilizer from rolling over onto itself to prevent, or at least inhibit medical instruments from being damaged during a sterilization procedure.

As noted above, Adams clearly discloses that the apparatus is a mat and the Applicant admits that the field of the invention is a mat for use in a sterilization container system (page 10, line 1 of the Remarks file on July 11, 2008). Therefore, the Applicant's instant invention and Adams are analogous art. Furthermore, In response to applicant's argument that the mat is for use in a sterilization container system, which is not analogous art with the Adams reference, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention

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and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is also noted that the Adams reference is merely relied upon to disclose a mat with a plurality of ridges on the downward surface of the mat so that no fold line can traverse that mat from one side to the other without intersecting at least one ridge. This is provided among other things, to keep the mat from moving or creeping and provide a cushioning effect for objects on the upward surface of the mat (column 3, lines 5-10). Thus, one of ordinary skill would easily be motivated to modify the mat of Frieze to comprise a plurality of ridges on the downward surface of the mat so that no fold line can traverse that mat from one side to the other without intersecting at least one ridge in order to keep the mat from moving or creeping as well as provide a cushioning effect for objects on the upward surface of the mat as exemplified by Adams.

*(c) Applicant submits that Nakahira does not disclose a mat for use in a sterilization container system having a **pattern of ridges extending from a downwardly facing surface, wherein the pattern is such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge.** Nakahira discloses radial projections that form a pattern such that a fold line **could** traverse the body 1 from one side to the other, within valleys 4b, for example, without intersecting at least one of ridge lines 4a (see Figs. 2 and 6). Further, Nakahira does not disclose or suggest preventing, or at least inhibiting the body 1 from folding.*

As shown in Figure 4, the projections are ridges (column 9, line 59) that occur in alternating fashion so that no fold line can traverse the mat from one side to the other without intersecting at least one ridge. Furthermore, the edge portions of the body 1 are ridges as well (column 10, lines 42-47). It is also noted that the limitations concerning preventing or inhibiting the body from folding are not disclosed in the claims and are therefore not given weight.

(d) Second, Nakahira is not within an analogous art to the art of the claimed invention and, therefore, cannot be used in a 35 U.S.C 103(a) rejection thereof. Applicant respectfully submits that such an endeavor [Nakahira disclosing a rubber material having excellent vibration proof, sound proof, shock absorbing and cushioning properties] is simply not within the field of endeavor of the invention of Independent claim 1, i.e., a mat for use in a sterilization container system. One of ordinary skill in the sterilization art would not look to such a rubber material to solve the problem of preventing, or at least inhibiting, a sterilization mat of folding over itself in a sterilization container system to prevent instruments from being damaged by contacting each other, or otherwise shifting, during a sterilization process.

Nakahira clearly discloses that the present invention is directed to a mat that is fully capable of being used in a sterilization container system (column 4, lines 40-47). Furthermore, in response to applicant's argument that the mat is for use in a sterilization container system, which is not analogous art with the Nakahira reference, a recitation of the intended use of the claimed invention must result in a structural difference between

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the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is also noted that the limitations concerning preventing or inhibiting the body from folding are not disclosed in the claims and are therefore not given weight. Finally, Nakahira clearly discloses that the mat inhibits vibrations during various procedures, wherein one of ordinary skill would recognize that the advantageous vibrational inhibition would aid in preventing the surgical instruments from damaging themselves during the sterilization procedure of Frieze. Therefore, the combination is suitable.

(e) In addition to the above, the combination of Frieze in view of either Adam and/or Nakahira can not be sued to reject Independent claims 1, 14 and 15 as the various combinations are respectfully made solely by an impermissible hindsight based on reconstruction.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

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1971). Furthermore, as set forth above, clear motivation is provided to combine Frieze with either Adams or Nakahira.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN C. JOYNER whose telephone number is (571)272-2709. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth L McKane/
Primary Examiner, Art Unit 1797

KCJ